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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/708,112 | 02/10/2004 | Robert G. Barnes | 03292.101300.1 | 2111 |
| 66569 7590 04/09/2007 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | EXAMINER MEYERS, MATTHEW S | |
| | | | ART UNIT 3629 | PAPER NUMBER |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/09/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/708,112 | BARNES ET AL. | |
| | Examiner | Art Unit | |
| | Matthew S. Meyers | 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This communication is in response to applicant's communication on 1/31/07, wherein claims 1-11 are currently pending.

Response to Amendment

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Vance et al (US 7,050,986) (Hereinafter Vance) in view of Evans et al. (US 2003/0126033 A1) (Hereinafter Evans).

5. With respect to **Claim 1**:

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Vance discloses a computer-implemented method for facilitating an automated redemption of an unused electronic ticket comprising steps of (Vance, column 10, lines 29-37, Fig. 11):

setting, via a computer system, an aging period (Vance, column 10, lines 29-37, Fig. 11, "lists tickets older than a given number of days");

identifying, via a computer system, a scheduled date of an issued ticket; (Vance, column 10, lines 29-37, Fig. 11, item 312, "data from table");

notifying a client (Vance, column 10, lines 35-37, "reports");

Vance does not explicitly disclose, adding, via a computer system, the aging period to the scheduled date and, if the scheduled date plus the aging period is earlier than a current date, determining, via a computer system, whether the ticket has been used; if the ticket has not been used, identifying the ticket as an unused ticket; and calculating, via a computer system, a redemption value of the ticket;

However, Evans teaches a system for calculating the redemption value of a service or product (software licenses), when the item is returned (Evans [0282] and [0162] "...and goods and for accepting orders and payments therefor for travel related services by currency or credit card."). Evans system automatically determines whether to issue a full, partial or no refund at all. This calculation is based on whether the software is used or unused along with the age of the software. Much like Evans, the present claim is merely calculating the residual value of a service or good by determining if the service or good has been used by the aging period. Moreover, the

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examiner interprets a software license to be analogous to an electronic ticket; both are licenses.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the tracking system of Vance with the automated redemption/refund system in Evans so that the tracking system in Vance would be able to automate its returns, thereby increasing customer productivity and reducing business latency.

6. **Claims 2-5 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance in view of Evans as applied to claim 1 above, and further in view of Business Wire article, entitled "American Express Expands RoundTrip Services With Array of New Products and Services" (July 15, 1997) (Hereinafter referred to as Business Wire).

7. With respect to **Claim 2**:

Vance discloses the reporting of unused tickets (Vance col. 10, lines 30-37). Nevertheless, neither Vance nor Evans explicitly discloses a step of processing, by the client travel agency, a refund of the unused ticket. However, Business Wire teaches the step of processing, by said client travel agency, a refund of said unused ticket (Business Wire Paragraph 8, "Ticket TRAX is a service that identifies unused electronic tickets and initiates the refund process..."). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reporting of unused tickets as disclosed in Vance and the automated redemption/refund system in Evans with the Ticket TRAX service as taught in Business Wire to simplify the arduous task of not only

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tracking a corporations unused tickets but to refund them as well. This combination would logically address the need set forth by Vance, for a corporate travel planning and management system, which allows automated travel planning and expense reporting (Vance col. 2, lines 33-39).

8. With respect to **Claim 3**:

Business Wire discloses the step of notifying includes notifying the client travel agency by submitting a report of unused tickets (Business Wire Paragraph 8, "...notifying the traveler and delivering monthly reports to the travel manager.").

9. With respect to **Claim 4**:

Business Wire discloses collecting ticket data from a financial transaction account, wherein the ticket data is used to determine an issued ticket for any plurality of selected purchasers (Business Wire Paragraph 9, "The software then enables companies to approve and audit the expense reports electronically and post them to general account systems.).

10. With respect to **Claim 5**:

Business Wire discloses wherein the ticket is at least one of a paper ticket and an electronic ticket (Business Wire Paragraph 8, "Ticket TRAX is a service that identifies unused electronic tickets...").

11. With respect to **Claim 7**:

Business Wire discloses the ticket is an electronic ticket which that includes a plurality of data fields and wherein the step of calculating, includes the plurality of data fields to a customer service tool and receiving the redemption value from the customer

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service tool (Business Wire Paragraph 8, "Ticket TRAX is a service that identifies unused electronic tickets and initiates the refund process, notifying the traveler and delivering monthly reports to the travel manager.").

12. With respect to **Claim 9**:

13. Business Wire discloses wherein the ticket corresponds to any of a plurality of selected purchasers (Business Wire Paragraph 8, "Ticket TRAX is a service that identifies unused electronic tickets and initiates the refund process, notifying the traveler and delivering monthly reports to the travel manager.").

14. **Claims 6 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance in view of Evans as applied to claim 1 above, and further in view of M2 Presswire article, entitled "American Express Ticket TRAX service launches for American Express business travel clients" (March 12, 1999) (Hereinafter referred to as M2 Presswire).

15. With respect to **Claim 6**:

Neither Vance nor Evans discloses the step of separating non-refundable tickets. However, M2 Presswire teaches separating non-refundable tickets (M2 Presswire Paragraph 4 "During pilot test, American Express found that nearly two percent of all electronic tickets contain at least one refundable segment...") (Examiner notes that in order to find that nearly two percent of all electronic ticket contain at least one refundable segment it would be necessary to separate non-refundable tickets out). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reporting of unused tickets as disclosed in Vance and the automated

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redemption/refund system in Evans with the Ticket TRAX service as taught in M2

Presswire in order to properly process the automated returns.

16. With respect to **Claim 8**:

M2 Presswire discloses the step of identifying is based upon an analysis of at least one of a client travel agency database and a global distribution system (M2 Presswire Paragraph 6, "The Ticket Trax system logs a record of all electronic tickets booked by a corporation's employees through American Express Travel. Then it checks the computer reservations systems (CRSs) after a specified period of time to determine if all segments of the ticket were used.").

17. **Claims 10-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance et al (US 7,050,986) (Hereinafter Vance) in view of Business Wire Article entitled "American Express Expands RoundTrip Services With Array of New Products and Services" (July 15, 1997) (Hereinafter referred to as Business Wire), and further in view of Evans et al. (US 2003/0126033 A1) (Hereinafter Evans).

18. With respect to **Claims 10 and 11**:

Vance discloses a computer system and program product comprising a processor and a memory storing control logic for causing the processor to perform a method for facilitating an automated redemption of an unused ticket (Vance, column 4, lines 4-30, column 10, lines 29-37, and Fig. 11), wherein the control logic includes:

setting an aging period (Vance, column 10, lines 29-37, Fig. 11, "lists tickets older than a given number of days");

identifying a scheduled date of an issued; (Vance, column 10, lines 29-37, Fig. 11, item 312, "data from table");

notifying at least one client travel agency (Vance, column 10, lines 35-37, "reports")

Vance does not explicitly disclose adding the aging period to the scheduled date and, if the scheduled date plus the aging period is earlier than a current date, identifying whether the issued ticket has been used or calculating a redemption value of the unused issued ticket.

However, Evans teaches a system for calculating the redemption value of a service or product (software licenses), when the item is returned (Evans [0282] and [0162] "...and goods and for accepting orders and payments therefor for travel related services by currency or credit card."). Evans system automatically determines whether to issue a full, partial or no refund at all. This calculation is based on whether the software is used or unused along with the age of the software. Much like Evans, the present claim is merely calculating the residual value of a service or good by determining if the service or good has been used by the aging period. Moreover, the examiner interprets a software license to be analogous to an electronic ticket; both are licenses.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the tracking system of Vance with the automated redemption/refund system in Evans so that the tracking system in Vance would be able to automate its returns, thereby increasing customer productivity.

Vance discloses a refund but it does not explicitly disclose, a system which adds the aging period to the scheduled date and, if the scheduled date plus the aging period is earlier than a current date, identifying whether the issued ticket has been used

However, Business Wire teaches a system that identifies unused electronic tickets and initiates the refund process ("Ticket TRAX is a service that identifies unused electronic tickets and initiates the refund process, notifying the traveler and delivering monthly detailed reports to the travel manager.") (Business Wire, paragraph 8, line 7).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the tracking system of Vance with the service that identifies unused electronic tickets and offers to redeem the ticket system as taught by Business Wire so that the tracking system in Vance would be able to further automate its returns by taking the next step and presenting the offer to redeem. This final step would reduce ticket costs and encourage firms to embrace electronic ticketing. (Business Wire, paragraph 7, lines 5-6).

Response to Arguments

Applicant's arguments filed 1/31/07 have been fully considered but they are not persuasive.

With respect to applicant's argument regarding the combination of Vance, Business Wire, and Evans, Examiner respectfully disagrees. One cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. In re Keller, 208 USPQ 871 (CCPA 1981). Vance, Evans and Business Wire together address a computer-implemented method which may facilitate the automated redemption of an unused electronic ticket. Moreover, Vance system describes a ticket tracking system which is able to calculate and determine the age of a ticket, as well as determine if it has been refunded or voided (Vance col. 10, lines 30-37). This determination is performed by using a corporate database which is in connection with a SABRE data feed of all booked data and back office system data as well as a hand-off of exchange and void ticket information (Vance Fig 2, and abs). Additionally, Evans, teaches a system for automating refunds. Evans system does teach the ability to be used for travel related services (Evans [0163]). Finally, Business Wire, another travel related reference, teaches a system which essentially combines the identification process with initiating a refunding. Therefore, taken as a whole, this combination would be permissible.

With respect to applicant's argument regarding a software license. Evans contemplates using its system for travel related services (Evans [0163]). That being said, Evans system would be reasonably pertinent to the particular problem addressed by applicant. Additionally, Evans system is able to discern between whether software is refundable or non-refundable by addressing several issues, including whether the product is authentic (paragraph [0020]), or if the product was used (Evans [0282]). Moreover, analogous art is that which is relevant to consideration of obviousness under 35 USC 103, and relevant criteria in determining whether prior art is analogous to claimed subject matter are whether art is from same field of endeavor, regardless of

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problem addressed, and if not, whether it is still reasonably pertinent to particular problem to be solved. *Wang Lab. v. Toshiba Corp.*, 993 F.2d 858, 864 (Fed. Cir. 1993). Therefore, Evans provides a solution to automating refunds, this solution would be applicable to its system which includes travel related services.

With respect to applicant's argument regarding the motivation to combine Vance in view of Evans with Business Wire and M2 Presswire, Examiner respectfully disagrees. As stated above, Vance is in connection with the SABRE system. Using SABRE in conjunction with Vance would enable its user to completely automate its travel expenses. Therefore, the motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. In *re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). As we explained in *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 (Fed. Cir. 1997), "there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention. Rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art."

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

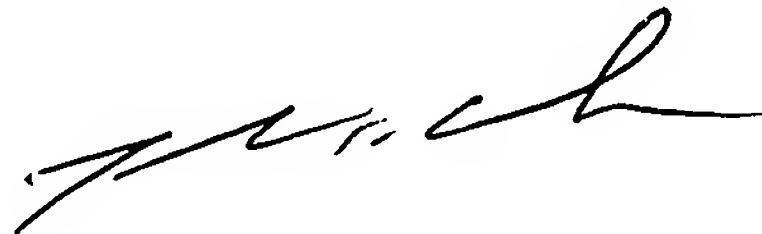
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Meyers whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571)272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSM
3/30/07



Matthew S. Meyers
Examiner
3629